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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,720	12/24/2003	Yoshitaka Mishima	2038-319	8317

7590 06/01/2006

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EXAMINER

ANDERSON, CATHARINE L

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/743,720	Applicant(s) MISHIMA ET AL.	
	Examiner C. Lynne Anderson	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13, 15-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 11, 14 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 16 March 2006 have been fully considered but they are not persuasive.

In response to the applicant's argument that the thermoplastic film of Inoue does not anticipate the claimed invention, it is noted that the thermoplastic film of Inoue comprises the identical materials and chemical composition as the claimed invention. The thermoplastic film of Inoue comprises a polyolefin resin consisting of polyethylene or polypropylene, as disclosed in column 4, lines 63-64. The film further comprises inorganic particles such as calcium carbonate or titanium dioxide, as disclosed in column 4, line 67, to column 5, line 3. The film is monoaxially or biaxially stretched, as disclosed in column 4, lines 57-59, which creates pores in the film around the inorganic particles. The porous nature of the film and the presence of swellable inorganic particles allow the film of Inoue to absorb water. Since the film of Inoue has the same composition and physical structure of the instant invention, it must have the same physical properties, and therefore will exhibit a transmittance of 40% or lower in a dry state and 60% or higher in a wet state, and a Klemm's water-absorbency of 1 to 10 mm and 5% to 100%.

Specification

The amendment filed 16 March 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added

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material which is not supported by the original disclosure is as follows: The entire inner surface of the thermoplastic film being in direct contact with the absorbent core is not supported in the instant specification. The masking sheet 21 comprising the thermoplastic film is positioned directly in contact with the indication element 19, as shown in figure 2 of the instant specification. While the outer portions of the thermoplastic film is in direct contact with the absorbent core, the entire inner surface of the film is not. Therefore, the limitation claiming the entire inner surface of the thermoplastic film is in direct contact with the absorbent core is not supported in the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation claiming the entire inner surface of the thermoplastic film is in direct contact with the absorbent core is not supported in the instant specification, as described in Objection to the Specification above, and is therefore considered new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6-10, 12-13, 15-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al. (6,747,185).

With respect to claims 1, 2, 9, and 12, Inoue discloses an absorbent article, as shown in figure 1, comprising a liquid pervious sheet 2, a liquid impervious sheet 3, and an absorbent core 4. An indicator 6 is interposed between the liquid impervious sheet 3 and the absorbent core 4. A water absorbent sheet 11 is disposed facing the liquid impervious sheet 3, and comprises a porous thermoplastic film, as disclosed in column 4, line 63, to column 5, line 3. The film comprises the same materials and physical characteristics of the film disclosed in the instant specification as having a transmittance of 40% or lower in a dry state and 60% or higher in a wet state, and a Klemm's water-absorbency of 1 to 10 mm and 5% to 100%, and therefore the film 11 inherently comprises the claimed characteristics.

With respect to claim 6, the thermoplastic film is monoaxially or biaxially stretched, as disclosed in column 4, lines 57-59.

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With respect to claim 7, the indication element 6b comprises a coating material, as disclosed in column 4, lines 1-3, which is positioned against the inner surface of the film 11, as shown in figure 2.

With respect to claim 8, the indication element 6b is visible against the absorbent core 4, and therefore is defined by the core.

With respect to claims 10, 13, and 18, the presence of the inorganic particles gives the film, and therefore its inner and outer surfaces, a rough surface. The stretching of the film disclosed in column 4, lines 57-59, creates pores which are capable of being filled with bodily fluid.

With respect to claim 15, the area disclosed by the instant claim is not defined as the surface area. Therefore, the cross-sectional area of the thermoplastic film 11 is smaller than that of the core, as shown in figure 3.

With respect to claim 16, an ink pattern 6b is provided between the film and the absorbent core, as shown in figure 2.

With respect to claim 17, the inner surface of the thermoplastic film 11 is substantially entirely in direct contact with the absorbent core, as shown in figure 2.

With respect to claim 20, the film is thermoplastic.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (6,747,185) in view of McCormack et al. (5,955,187).

Inoue discloses all aspects of the claimed invention with the exception of the size of the inorganic particles. McCormack teaches a porous thermoplastic film comprising from 10-70% of an inorganic filler in the range of 0.1-7.0 microns, as disclosed in column 6, lines 12-34. The inorganic filler is hydrophilic, and therefore swells to fill the pores in the film when the inorganic filler absorbs water. This allows the film to be vapor permeable and yet become moisture impermeable when necessary, as disclosed in column 2, lines 38-50. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the porous thermoplastic film of Inoue with hydrophilic inorganic filler material, as taught by McCormack, to allow the film to be vapor permeable and yet become moisture impermeable when necessary.

Allowable Subject Matter

Claims 4, 5, 11, 14, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose the claimed invention. Specifically, Inoue fails to disclose the thermoplastic film containing a modifier to impart hydrophilicity. The thermoplastic film of Inoue is provided in the absorbent article to act as a barrier layer. While the inorganic particles and porous nature of the film of Inoue allow some degree of water absorption by the film, modifying the film to become

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hydrophilic would teach against the intended use of the film. Therefore, Inoue does not teach nor fairly suggest the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ca

cla

May 25, 2006

TATYANA ZAITSEVA
SUPERVISORY PRIMARY EXAMINER

